

mutual dynamic authenticity test as recited in claim 8, the Examiner asserts that the Hurta reference does not explicitly teach one data word constantly changing (the “data word feature”). However, the Examiner contends that the data word feature is “deemed to be inherent to Hurta to either establish a random number generator for a mutual dynamic authenticity matching or generating a public key to match a private key or as a ‘dummy’ data word to confuse potential hackers.” The Examiner also contends that while the Hurta reference does not teach an interrupt-sensitive time period as recited in claim 8, this feature is also inherent in microprocessor systems.

To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997).

The Hurta reference relates to a system in which an interrogator transmits an interrogation signal to a transponder, in response to which the transponder transmits back to the interrogator a response signal. (Hurta reference, Col. 1, ll. 13-16). The system disclosed in the Hurta reference allows a user to use a smartcard and a smartcard-based transponder in order to pay tolls when used in conjunction with the interrogator. (Hurta reference, Col. 2, ll. 23-33).

Claim 8 recites, inter alia, the following:

“A method for posting debit information to a mobile intelligent storage device using a terminal, the terminal being in a wireless, secure communication with a computer, the method comprising the steps of:

performing a mutual dynamic authenticity test between the computer, the terminal and the storage device using at least one data word, the at least one data word constantly changing;

before an interrupt-sensitive time period, transmitting a first data word of the at least one data word from the storage

device to the terminal, the first data word being generated for the mutual dynamic authenticity test;

during the interrupt-sensitive time period, transmitting a particular signal from the terminal to the storage device, the particular signal including a posting triggering signal, a posting data record, an identifier generated using the first data word and a second data word of the at least one data word generated by one of the computer and the terminal;

checking the identifier, using the storage device; . . .

generating a further identifier as a function of the second data word, using the storage device; . . .” (Emphasis added).

Before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is **necessarily** present in the reference. See SGS-Thomson Microelectronics, Inc. v. International Rectifier Corp., 32 U.S.P.Q.2d 1496, 1503 (Fed. Cir. 1994), (*citing* Continental Can Co. USA v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)). The test of inherency is not satisfied by what a reference **may** teach. *Id.* The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art. See Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

In regard to authentication, the Hurta reference states that the microcontroller 78 of the transponder 14 “authenticates” that a smartcard 66 is compatible with the transponder 14 application. Next, the microcontroller 78 may optionally begin an “authorization” process in which the user inputs a PIN through the keyboard 76. The Hurta reference also discusses a smart card certificate which comprises a portion of unencrypted data and encrypted data. The smartcard 66 generates this data and stores it in the transponder 14. An encrypter/decrypter 84 which is provided in communication with the microcontroller 78 encrypts and decrypts data which is transferred to and from the smartcard 66. In terms of a toll transaction sequence, an interrogator 10 will interrogate the transponder 14 such that the transponder 14 sends a response which includes identity and payment information along with an account

authorization code that is an encrypted confirmation code. The authentication process described in the Hurta reference fails to describe or suggest the use of the data word feature as recited in claim 8. More particularly, the Hurta reference fails to even suggest the authentication process as recited in claim 8, especially since the Hurta reference simply states that the transponder 14 authenticates the smartcard 66 without any detail as to what takes place during authentication. Furthermore, the authorization process of the Hurta reference cannot be equated with the authenticity test of claim 8. As stated above, the interrogator 10 of the Hurta reference merely receives an authentication code, and there is simply no suggestion that this code changes. The Hurta reference simply does not describe in sufficient detail the steps associated with the encryption/decryption processes to support the Examiner's contention the Hurta reference inherently contains the use of at least one data word which constantly changes, as recited in claim 8. Accordingly, it is respectfully submitted that one skilled in the art would not, by simply viewing the Hurta reference, understand that the use of the data word feature as recited in claim 8 is **necessarily** present in the Hurta reference.

Based on the foregoing, it is respectfully submitted that the Hurta reference does not anticipate claim 8. Claims 9-17 depend from claim 8, therefore the above argument in regard to claim 8 applies equally to claims 9-17. Withdrawal of this rejection is, therefore, respectfully requested.

CONCLUSION

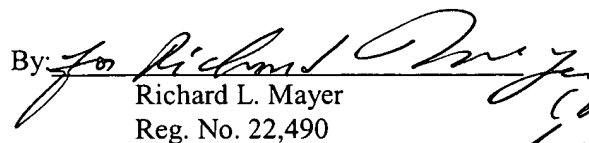
In light of the foregoing, Applicants respectfully submit that all of the pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

The Office is authorized to charge any fees associated with this Response to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

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